



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/356,926	07/19/1999	WIM J. VAN OOL	19789-008	8477

7590 01/02/2003

DINSMORE & SHOHL LLP
1900 CHEMED CENTER
255 EAST FIFTH STREET
CINCINNATI, OH 45202

EXAMINER

LAVILLA, MICHAEL E

ART UNIT PAPER NUMBER

1775

DATE MAILED: 01/02/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/356,926

Applicant(s)
Van Ooij et al.

Examiner
LA VILLA

Art Unit
1775



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 26, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 12, 17
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 26 September 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/356,926 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-6, 9, 10, 12-17, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. USP 6,071,566 for the reasons of record in the Office Action mailed on 26 March 2002.

Response to Amendment

- I. In view of applicant's amendments and arguments, the section 103 rejections over Bishop and Poutasse of the Office Action mailed on 26 March 2002 are withdrawn.
- II. Applicant has filed a declaration by Inventor Ooij, dated 26 September 2002. The declaration provides evidence of the performance of two silane solutions encompassed by the claimed compositions, each solution having a vinylsilane compound and one of either a bis-silyl monoaminosilane or a bis-silyl diaminosilane compound. Utilization of both of these solutions resulted in performance superior to a solution comprised of vinyl silane alone.
- III. In view of applicant's amendments, argument, and declaratory evidence, applicant traverses the section 103 rejection over Brown of the Office action mailed on 26 March 2002. The presented evidence is not persuasive that the claimed mixture of silanes is not prima facie obvious with respect to the mixtures disclosed by Brown. In the declaration and applicant's Specification, applicant compares solutions comprised of bis-silyl aminosilane and vinylsilane compound

mixtures to solutions comprised of vinylsilane compounds alone. However, Brown teaches combining vinylsilane compounds with other multisilyl silanes, including those of the claimed aminosilane variety, rendering the claim obvious. It would appear that applicant must demonstrate that the claimed variety of bis-silyl aminosilane compounds when combined with vinylsilanes provide unexpected results as compared to other multisilyl silanes combined with vinylsilanes. Applicant's Specification at the top of page 17 suggests that BTSE combined with vinylsilane provides inferior performance as compared to the claimed aminosilane compounds combined with vinylsilane. However, Brown's experiment with a similarly comprised solution and with pH values closer to those of applicant's bis-silyl aminosilane experiments appears to provide results that compare favorably to applicant's bis-silyl aminosilane compound mixtures (See Tables 1 and 2 in Brown, where Brown achieves 24 hr and 14 day test results comparable to applicant's bis-silyl aminosilane results). Therefore, the rejection is maintained in the absence of preponderance of evidence that the claimed mixtures provide unexpected results, as compared to the prior art teachings, over the breadth of the claimed invention.

Art Unit: 1775

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (703) 308-4428. The examiner can normally be reached on Mondays and Tuesdays.
6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.
7. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Michael La Villa
December 27, 2002

A handwritten signature in black ink, appearing to read 'La Villa', with a long, sweeping horizontal line extending to the right.